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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

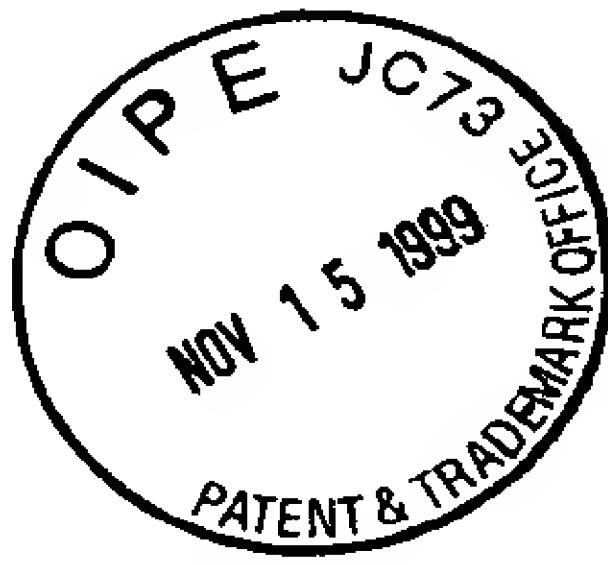
In re application of:

Birnstiel *et al.*

Appl. No: 08/380,200

Filed: January 30, 1995

For: **New Protein-Polycation
Conjugates**



Art Unit: 1644

Examiner: Cunningham, T.

Atty. Docket: 0652.1080001/RWE/KKV

Reply To Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office action dated **July 15, 1999**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants refer to a telephone conversation between Applicants' representative and the Examiner wherein Applicants' representative indicated that the Restriction Requirement is inappropriate at this stage in prosecution. The Examiner agreed to withdraw the Restriction Requirement, but maintained the species election. Thus, Applicants hereby provisionally elect to prosecute the species represented by claims 1, 2, 8, 11-18 and 36. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. However, this election is made **with traverse** on the basis that the Restriction Requirement as a whole, i.e., including the species election, is inappropriate.

According to MPEP § 811.02, a Restriction Requirement is appropriate "at any stage of prosecution *up to final action*" (emphasis added). Applicants received a final Office action on August 13, 1998, and in response thereto, filed a Notice of Appeal and an Appeal Brief on May 10, 1999. A Restriction Requirement was not received prior to August 13, 1998.

It is noted that the Examiner withdrew finality in the July 15, 1999, Office action, and thus, presumably, reopened prosecution. However, according to MPEP §§ 706.07(e) and 1208.02, prosecution cannot be reopened without the approval of the supervisory patent examiner. Moreover, even with the approval of the supervisory patent examiner, prosecution can only be reopened "to enter a new ground of rejection." MPEP § 1208.02. The Examiner did not reject a single claim in the July 15, 1999, Office action and a Restriction Requirement does not qualify as a "new ground of rejection." In addition, the Examiner did not clearly indicate that prosecution has been reopened. Thus, it is not clear if Applicants must respond as indicated in MPEP § 1208.02 and either file a reply under 37 C.F.R. §§ 1.111 or 1.113 or request reinstatement of the appeal.

In MPEP § 706.07(e), withdrawing the finality of an Office action is described as appropriate when "a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious." The application of a Restriction Requirement is not mentioned as an appropriate basis for withdrawing finality.

On page 2 of the Office action, the Examiner indicated that the application had been transferred to him from a previous Examiner. However, this is also not the basis for a Restriction Requirement. As noted by MPEP § 704:

"[w]hen an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general *the second examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something*" (emphasis added).

Finally, Applicants point out that the parent application, Application No. 07/946,498, was filed November 9, 1992, and this Rule 60 continuation was filed January 30, 1995. Given the

length of time that this application has been pending and the substantial costs associated with the lengthy prosecution of the application, Applicants assert that the Restriction Requirement presents a serious and costly burden on Applicants. At this point, Applicants have already prosecuted the application fully before the Examining Corps. at the U.S. Patent & Trademark Office. Applicants have the right to an appeal and to have the application evaluated by the Board of Patent Appeals and Interferences. As noted by MPEP § 1201, "[w]here the differences of opinion [between Applicant and Examiner] concern the denial of patent claims because of prior art . . . the questions thereby raised are said to relate to the merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute."

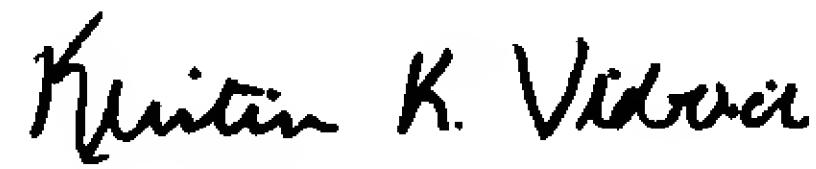
Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested. If the Examiner does not indicate that the claims are allowable, then Applicants respectfully request clarification as to whether prosecution is officially reopened so that Applicants can request reinstatement of the appeal, if necessary.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are

necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: Nov. 15, 1999

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